



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/177,711	10/23/1998	MICHAEL A. ADAMS	10692v-000210US	3493

20350 7590 02/26/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/177,711

Applicant(s)

ADAMS ET AL.

Examin r

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears n the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-62,64-72 and 74-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-62,64-72 and 74-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The Request for a Continued Examination (RCE) under 37 CFR 1.114 filed on December 3, 2002 based on parent Application No. 09/177711 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 60-62, 64-72 and 74-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "low" in claims 60 and 70 is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The claims are indefinite as to the amount of nitroglycerine employed in the method.

Claim Rejections 35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 60, 61, 63-71 and 73-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Kock et al. (U.S. Patent 5,849,803)

Kock et al. teaches method for treatment of erectile dysfunction in men by administering to the patient nitroglycerine along with prostaglandin. See, particularly, column 2, line 32 bridging column 3, line 17 and claims 1, 6 and 11-12.

The primary reference does not teach expressly the method would be less painful compared with method wherein prostaglandin is employed alone. However, such properties are considered inherently possessed by the prior art. Applicants' attention is directed to *Ex parte Novitski*, 26 USPQ2d 1389 (BOPA 1993) illustrating anticipation resulting from inherent use, absent a *haec verba* recitation for such utility. In the instant application, as in *Ex parte Novitski*, supra, the claims are directed to preventing pain associated with use of prostaglandin with old and well-known compounds or compositions. It is now well-settled law that administering compounds inherently possessing a protective utility anticipates claims directed to such protective use. Arguments that such protective use is not set forth *haec verba* are not probative. Prior use for the same utility clearly anticipates such utility, absent limitations distancing the proffered claims from the inherent anticipated use. Attempts to distance claims from anticipated utilities with specification limitations will not be successful. At page 1391, *Ex parte Novitski*, supra, the Board said "We are mindful that, during the patent examination, pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). As often stated by the CCPA, "we will not read into claims in pending applications limitations from the specification." *In re Winkhaus*, 52 F.2d 637, 188 USPQ 219 (CCPA 1975)". In the instant application, Applicants' failure to distance the proffered claims

Art Unit: 1617

from the anticipated therapeutical utility, renders such claims anticipated by the prior inherent use. Although the instant claims recite decrease pain associated with the use of prostaglandin, the steps of the method is identical to the cited prior art, i.e. administering nitroglycerine with prostaglandin to patient with sexual dysfunction.

Claim Rejections 35 U.S.C – 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 60-62, 64-72 and 74-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kock et al. (US Patent 5,849,803) in view of Akkus et al. (Medline Abstract, AN 95174112) and Cesar et al. (WO 94/04120)

Kock et al. teach method for treatment of erectile dysfunction in men by administering to the patient nitroglycerine along with prostaglandin. See, particularly, column 2, line 32 bridging column 3, line 17 and claims 1, 6 and 11-12. The particular preferred amount of nitroglycerine in the method is about 0.5 mg to 1.5 mg. See claim 4.

The primary references does not teach expressly the method would be less painful compared with method wherein prostaglandin is employed alone or employing the method for female, the particular amount of NO releasing compounds

However, Kock et al. do not teach a particular low limit of amounts of nitroglycerin. Further note Kock et al. particularly teach an intraurethral administration, which generally require much higher dosage compared with other administering route. See, col. 2, line 57

Art Unit: 1617

bridging col. 3, line 24. Akkus teach that prostaglandin is known to be similarly useful for female in promoting erection in genital tissue. See the abstract. Cesar et al. teach that method for treating sexual dysfunction employing prostaglandin is known to be useful both for male and female. See, page 12, line 19 bridging page 13, line 24.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employing a lower amounts nitroglycerine in treating sexual dysfunction, or employ the combination for treating female sexual dysfunction.

One of ordinary skill in the art would have been motivated to employing a lower amounts nitroglycerine compared with what preferred by Kock in treating sexual dysfunction, or employ the combination for treating female sexual dysfunction because Kick's preferred amounts is for intraurathral administration, and for other methods of administration, it would be obvious to lower the amount. Further optimization of a result effective parameter, e.g., effective amount of a known therapeutical agent in a known composition, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Further, it is well-settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered functional property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." Additionally, where the patent Office has reason to believe that a functionally limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to requires the applicant to prove that the subject matter

Art Unit: 1617

shown to be in the prior art does not possess the characteristic relied on. In the instant invention, the claims are directed to the ultimate utility set forth in the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner

A handwritten signature in black ink, appearing to read 'S. Wang' with a stylized flourish at the end.

Shengjun Wang

February 22, 2003